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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,401	01/30/2002	Vincent De Laforcade	05725.1014-00	5421

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EXAMINER

BOMBERG, KENNETH

ART UNIT PAPER NUMBER

3754

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/058,401

Applicant(s)

DE LAFORCADE, VINCENT

Examiner

Kenneth Bomberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-292 is/are pending in the application.
- 4a) Of the above claim(s) 18,51,81,114,147,177 and 193-292 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17,19-50,52-80,82-113,115-146,148-176 and 178-192 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 8
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-192 in Paper No. 7 is acknowledged.

The traversal is on the ground(s) that the office has failed to demonstrate two-way distinctness. This is not found persuasive because as stated in the restriction requirement of paper number 6, the combination claims do not require the particulars of the subcombination claims (see paper 6, paragraph 1). Applicant states that "independent claims 1, 34, 97, and 130 of Group I recite a substantial amount of the subject matter of independent claims 227, 244, 193, and 210, respectively, of Group II." With respect to this argument, the omission in the independent combination claims of particulars of the independent subcombination limitations is evidence of distinctness required for the restriction requirement. If these differences are inconsequential from a patentability standpoint and are therefore not properly restrictable, then their presence serves only to becloud the invention through repetitious and multiplied claims and should be eliminated to lift the haze of confusion surrounding the application claims.

Applicant's note that independent Claims 130 and 161 of Group I include a recitation relating to dispensing regardless of orientation; claim 34 of Group I includes a recitation concerning the non-elastically deformable material; and claims 1 and 97 of Group I include a recitation concerning the pressure in the pouch. While these observations are correct, it is also true that the recitation relating to dispensing regardless of orientation is omitted from independent combination claims 1, 34, and 65 of Group I; the recitation concerning the non-elastically deformable material is omitted from independent claims 1, 65, 97, and 161 of Group I; and the

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recitation concerning the pressure in the pouch is omitted from independent claims 34, 65, 130, and 161 of Group I. Thus ample evidence is present that each of the independent combination claims omits some details of at least one of the independent subcombination claims.

Applicant further argues that a proper examination of Groups I and II would overlap and therefore not present a burden to the examiner. With respect to this argument, applicant's failed to provide any factual support and the statement is therefore conclusory. The examiner has provided the requisite prima facie evidence of separate status as shown by their different classification.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 193-292 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

3. Applicant's election of the species of figures 1-5 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the species requirement, the species election has been treated as an election without traverse (MPEP § 818.03(a)).

4. Claims 18, 51, 81, 114, 147, and 177 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17, 19-50, 52-80, 82-113, 115-146, 148-176, and 178- 192 are rejected under 35 U.S.C. 112, second paragraph, as being repetitious and multiplied (undue multiplicity).

In view of the nature and scope of applicant's invention, applicant presents an unreasonable number of claims which, in view of the nature and scope of applicant's invention, are repetitious and multiplied, the net result of which is to confuse rather than to clarify. Consequently, applicant is required to select no more than 23 claims, three of which may be independent, from the elected invention of Group I and the elected species of figures 1-5.

The reasons supporting the undue multiplicity rejection are as follows:

**Claims are Repetitious and Multiplied**

The elected invention of the combination container pouch and pump encompass claims 1-192, six of these claims being independent (claims 1, 34, 65, 97, 130, and 161). All independent claims share in common a container, a flexible-walled pouch inside the container, a dip tube extending in the interior of the pouch, and an airless pump in fluid communication with the interior of the pouch via the dip tube. The remaining recitations of each independent claim are merely repetitious and multiplied permutations of additional conventional elements or conventional functional limitations which are well known in the prior art. The recitations in no material aspect differentiating them from the prior art.

Independent claim 1 further recites a product in the pouch, the relative length of the dip tube, an air passage into the container, and the relative operative relation of the

pressure in the pouch to the atmosphere. These recitations differentiate this claim in no material aspect since these recitations are conventional elements known in the art as evidenced by Corsette (US 3,420,413).

Independent claim 34 further recites the pouch configured to contain the product, the relative length of the dip tube, an air passage into the container, and the pouch being a non-elastically deformable material. These recitations differentiate this claim in no material aspect since these recitations are conventional elements known in the art as evidenced by Corsette (US 3,420,413).

Independent claim 65 further recites the pouch configured to contain the product, the relative length of the dip tube, an air passage into the container, and the pouch being fixed to an interior wall of the container. These recitations differentiate this claim in no material aspect since these recitations are conventional elements known in the art as evidenced by Corsette (US 3,420,413) and NOMOTO (EP 0 759 399 A1) (from French search report).

Independent claim 97 further recites a product in the pouch, an air passage into the container, the relative operative relation of the pressure in the pouch to the atmosphere, and the device configured to dispense substantially all of the product regardless of the device orientation. These recitations differentiate this claim in no material aspect since these recitations are conventional elements known in the art as evidenced by Corsette (US 3,420,413).

Independent claim 130 further recites the pouch configured to contain the product, an air passage into the container, the pouch being a non-elastically deformable material,

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and the device configured to dispense substantially all of the product regardless of the device orientation. These recitations differentiate this claim in no material aspect since these recitations are conventional elements known in the art as evidenced by Corsette (US 3,420,413).

Independent claim 161 further recites the pouch configured to contain the product, an air passage into the container, the pouch being fixed to an interior wall of the container, and the device configured to dispense substantially all of the product regardless of the device orientation. These recitations differentiate this claim in no material aspect since these recitations are conventional elements known in the art as evidenced by Corsette (US 3,420,413) and NOMOTO (EP 0 759 399 A1) (from French search report).

Each of the claims is followed by a series of dependent claims which are further repetitious and unduly multiplied. By way of example:

Claim 3 dependent upon independent claim 1 incorporates limitation of the pouch being fixed to an interior wall of the container found in independent claims 65 and 161.

Claim 36 dependent upon independent claim 34 incorporates limitation of the pouch being fixed to an interior wall of the container found in independent claims 65 and 161.

Claim 99 dependent upon independent claim 97 incorporates limitation of the pouch being fixed to an interior wall of the container found in independent claims 65 and 161.

Claim 128 dependent upon independent claim 97 incorporates limitation of the pouch being a non-elastically deformable material found in independent claims 34 and 130.

Claim 132 dependent upon independent claim 130 incorporates limitation of the pouch being fixed to an interior wall of the container found in independent claims 65 and 161.

Claim 191 dependent upon independent claim 161 incorporates limitation of the pouch being a non-elastically deformable material found in independent claims 34 and 130.

The sets of claims dependent from each of the independent claims are substantially the same and are therefore repetitions and unduly multiplied.

The degree of repetition and multiplicity of the claims beclouds definition of the invention in a maze of confusion. Further as evidenced by Corsette (US 3,420,413), numerous limitations of the dependent claims are directed to structures or functional limitations which are conventional in the art and do not materially differentiate the invention.

In View Of The Nature And Scope Of Invention The Number Of Claims Are Not Supported By The Rule Of Reason

It is initially noted this application claims priority to French application 2001 FR-0001224, and has related applications CA 2368055 A1, EP 1226874 A1. Applicant in each of these applications had less than 24 claims. This fact is indicative that the initial presentation of 292 claims is unnecessary.



Applicant has provided an information disclosure statement including two US references, these art references contain respectively 3 and 20 claims. Further, the relevant art references provided by the examiner in this action contain no more than 20 claims each. As all of these references are related to the same art area as applicants endeavor, in view of the nature and scope of applicant's invention, applicant presents an unreasonable number of claims. The net result of the repetitious and multiplied claims is to confuse rather than clarify.

As noted by the court in *In re Chandler*, 319 F.2d 211, 225, 138 USPQ 138, 148 (CCPA 1963), "applicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged. Such latitude, however, should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion. The rule of reason should be practiced and applied on the basis of the relevant facts and circumstances in each individual case." For the reasons as stated above, and in view of the facts and evidence of this case, the multiplicity rejection is appropriate.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Bomberg whose telephone number is (703) 308-2179. The examiner can normally be reached on Monday-Thursday from 9:30 AM - 7:00 PM. The examiner can also be reached on alternate Fridays.

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The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

A handwritten signature in black ink, appearing to read 'Ken Bomberg', with a stylized flourish at the end.

KENNETH BOMBERG  
PRIMARY EXAMINER  
ART UNIT 3754

K.B.

January 8, 2004